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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,063	01/25/2000	Jane E. Polston	UF-232XC1	8057

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EXAMINER

GIBBS, TERRA C

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/491,063	<b>Applicant(s)</b> POLSTON ET AL.	
	<b>Examiner</b> Terra C. Gibbs	<b>Art Unit</b> 1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 22-42.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

  
**ANDREW WANG**  
**SUPERVISORY PATENT EXAMINER**  
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Continuation of 11. does NOT place the application in condition for allowance because: The request for reconsideration has been fully considered but does not place the application in condition for allowance because claims 22-42 would remain rejected under 35 U.S.C. 102(e) as being anticipated by Stout et al. In response to this rejection, Applicants argue that the Stout et al. patent does not teach a transgenic plant comprising a polynucleotide that encodes a wild type or non-mutated tomato mottle virus Rep protein. Applicants contend that "RTSC" is not for a transgenic plant, but instead refers to an Agrobacterium that is transformed with a polynucleotide construct comprising a wild type tomato mottle virus. Applicants contend that nowhere does the Stout patent discuss or describe the transformation of a plant with "RTSC". Applicants further contend that Table 2 provides a list of tomato plants transformed with various constructs, but "RTSC" is not shown within Table 2. The Examiner has fully considered this argument but has not found it to be persuasive. The Examiner would like to point Applicants to column 22, lines 1-3 which recites, "Table 2 summarizes the transgenic tomato plants produced by transfer of wildtype ToMoV ORF DNA into the plant by Agrobacterium infection". The Examiner would like to further point Applicants to the previous Office Action mailed December 23, 2004, at page 6, first full paragraph, where it discusses MPEP 2112 [R-2]: Requirements of Rejection Based on Inherency; Burden of Proof: "The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103". Although there seems to be some discrepancy between column 22, lines 1-3 and what is disclosed in Table 2, as Table 2 only identifies plants transformed with "RTAC" (antisense) and not "RTSC" (sense), the disclosure at column 22, lines 1-3 literally and expressly supports what is instantly claimed. Therefore, the Examiner disagrees with Applicants argument that the Stout et al. patent does not teach a transgenic plant comprising a polynucleotide that encodes a wild type or non-mutated tomato mottle virus Rep protein, as column 22, lines 1-3 literally and expressly supports such a transgenic plant. In this regard, and as Applicants have requested, the Examiner has specifically identified in the text of the Stout et al. patent the literal and expressed description of a transgenic plant transformed with a polynucleotide that encodes a non-mutated Rep protein of tomato mottle virus (see column 22, lines 1-3). It is noted that this description is also supported in the Stout patent at column 4, lines 64-67 which recites, "Transgenic plants resistant to ToMoV were created by transforming them with an AC1 ORF derived from ToMoV and engineered to contain similar mutations".